

## **REMARKS**

By this Reply, Applicants have amended claims 19 and 36, and added new claims 37-46. No new matter has been added. Claims 19-46 are pending on the merits.

As an initial matter, Applicants appreciate the Examiner's indication that claims 19-36 would be allowable if amended to overcome the claim rejection under 35 U.S.C. § 101. Office Action at 5. Applicants respectfully note that claims 27-36 were not rejected in the Office Action and do not depend from any of rejected claims 19-26. For at least this reason, claims 27-36 should be allowable without amendment. If, in response to this Reply, the Examiner does not issue a Notice of Allowance and issues an Office Action, which includes a rejection of any of claims 27-36, Applicants respectfully submit that it would be improper to designate such Office Action final.

### **I. Objection to the Abstract of the Disclosure**

In the Office Action, the Abstract of the Disclosure has been objected to based on an assertion that "[t]he abstract submitte[d] in the Preliminary [A]mendment filed on 23 September 2004 on pages 4 and 5 . . . is improper," because it was not filed on a separate sheet. Applicants respectfully traverse the objection because a copy of the Abstract of the Disclosure listed on pages 4-5 of Applicants' Preliminary Amendment filed on September 23, 2004, was provided on a separate sheet attached to the Preliminary Amendment. Nevertheless, for the Examiner's convenience, Applicants have attached a copy on a separate sheet of the Abstract of the Disclosure, and Applicants respectfully submit that the Abstract of the Disclosure complies with 37

C.F.R. § 1.52(b)(4) and M.P.E.P. § 608.01(b). Accordingly, Applicants respectfully request reconsideration and withdrawal of the objection to the Abstract of the Disclosure.

**II. Rejection of Claims 19-26 under 35 U.S.C. § 101**

Claims 19-26 were rejected under 35 U.S.C. § 101 based on an assertion that “[c]laim 19 lacks a useful, concrete, and tangible result.” Office Action at 4. In particular, the rejection statement asserts that “[t]he claim is directed to manipulation of ideas that are abstract in nature, as performing of the method does not result in an outcome that is for example, displayed, stored, or outputted to a user etc., by means of a tangible medium.” Id. (emphasis in original). The rejection statement further asserts that “[f]or the result to be tangible it would need to [be][sic] output to a user or displayed to a user or stored on data media for later usage[sic].” Id. (emphasis in original). The rejection statement thereafter concludes that the claims are treated as non-statutory functional descriptive material (See M.P.E.P. Section 2106).” Id.

Applicants respectfully traverse the § 101 rejection of independent claim 19 and claims 20-26, which depends therefrom, at least because the M.P.E.P.’s “tangible result” requirement does expressly require “output to a user, or display[] to a user or stor[age] on data media,” as asserted by the rejection statement. In particular, the M.P.E.P.’s “tangible result” test cautions that “[t]he tangible result requirement does not necessarily mean that a claim must either be tied to a particular machine or apparatus or must operate to change articles or materials to a different state or thing.”

§ 2106(IV)(C)(2.)(2)(b) (8<sup>th</sup> ed. August 2006). Rather, according to the M.P.E.P., the

“tangible result” requirement merely requires that a “process claim must set forth a practical application of that judicial exception to produce a real-world result.” Id. The M.P.E.P. concludes by advising that “the opposite meaning of ‘tangible’ is ‘abstract.’” Id. Thus, under the M.P.E.P.’s guidelines, a tangible result does not require “output to a user, or display[] to a user or stor[age] on data media,” as asserted by the rejection statement. The rejection statement’s assertion is simply not supported by the M.P.E.P. itself.

Applicants respectfully submit, that under the M.P.E.P.’s guidelines for a “tangible result,” Applicants’ independent claim 19 recites statutory subject matter at least because it is not “abstract.” Applicants’ independent claim 19 is directed to a method for monitoring instantaneous behavior of a tire in a rolling condition, including, *inter alia*, “comparing . . . at least one cyclic curve with . . . at least one reference curve; and emitting a signal depending on the comparison; wherein the at least one reference curve represents the acceleration profile of . . . at least one point [of the tire] in at least two directions, wherein the directions comprise two or more of a centripetal direction, a tangential direction, and a lateral direction, wherein the signals of acceleration of the at least one point in the at least two directions are continuously acquired, and wherein the emitted signal indicates the instantaneous behavior of the tire.” Thus, Applicants’ independent claim 19 is not “abstract” at least because claim 19 recites a practical application of a method for monitoring instantaneous behavior of a tire in a rolling condition, including emitting a signal having a particular, non-abstract characteristic.

For at least the above-outlined reasons, Applicants’ independent claim 19 meets the “tangible result” requirement specified in the M.P.E.P. Accordingly, Applicants

respectfully request reconsideration and withdrawal of the § 101 rejection of independent claim 19 and dependent claims 20-26, which depend from independent claim 19.

### **III. New Dependent Claims 37-46**

By this Reply, Applicants have added new dependent claims 37-46, which depend from one of allowable independent claims 19 and 36. In addition, dependent claims 37-46 recite additional novel and unobvious subject matter. For at least these reasons, new dependent claims 37-46 should be allowable.

### **IV. Conclusion**

For at least the above-outlined reasons, Applicants' independent claim 19 should be allowable. Dependent claims 20-26 and new dependent claim 37 depend from independent claim 19. Consequently, those dependent claims should be allowable for at least the same reasons independent claim 19 is allowable. Further, claims 27-36 have not been rejected and are allowable, and new dependent claims 38-46 depend from allowable independent claim 36. Accordingly, Applicants respectfully request reconsideration of this application, withdrawal of the objection and claim rejection, and allowance of claims 19-46.

If the Examiner believes that a telephone conversation might advance prosecution of this application, the Examiner is cordially invited to call Applicants' undersigned attorney at (571) 203-2739.

Applicants respectfully submit that the Office Action contains a number of assertions concerning the related art and the claims. Regardless of whether those assertions are addressed specifically herein, Applicants respectfully decline to automatically subscribe to them.

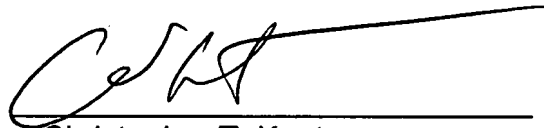
Please grant any extensions of time required to enter this Amendment and charge any additional required fees to our Deposit Account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,  
GARRETT & DUNNER, L.L.P.

Dated: June 12, 2007

By:



Christopher T. Kent  
Reg. No. 48,216

Attachment: Copy of Abstract of the Disclosure on Separate Sheet